

REMARKS

In response to the Office Action mailed October 24, 2003, Applicants amended claims 1, 16 and 21. Claims 1-6, 8-10, 14, 15 and 18-24 are presented for examination.

The Examiner objected to the specification, stating:

The specification fails to recite the limitation of the amount of non-electrolytic material in the composition being less than about 30%.

As currently presented, claims 1-6, 8-10, 14, 15 and 18-24 cover compositions in which the composition includes less than about 30 percent of non-electrolytic material by weight. This limitation is supported by the application as originally filed. (*See specification* page 8, lines 28-29). Accordingly, Applicants request reconsideration and withdrawal of the objection to the specification.

The Examiner rejected claims 1-6, 8-10, 14, 15 and 21-24 under 35 U.S.C. §112, first paragraph, as purportedly failing to comply with the written description requirement because, in the Examiner's view, Applicants' prior amendment to claims 1 and 21 constitutes new matter. Without conceding to the appropriateness of this rejection, Applicants have amended claims 1 and 21 to remove the limitation added to these claims by the prior amendment and to add the limitation "the composition comprises less than about 30 percent of non-electrolytic material by weight." As noted above, the specification as originally filed provides a written description of the claims as amended. (*Id.*) Moreover, a written description of this limitation is provided by claim 7 as originally filed. Applicants therefore request reconsideration and withdrawal of this rejection.

The Examiner also rejected claims 1-10, 14-16 and 18-24 under 35 U.S.C. §112, first paragraph because, in the Examiner's view, the application as originally filed does not provide a written description that supports the composition being "substantially free of carbon fibers." Without conceding that this rejection is appropriate, Applicants have amended the claims to obviate this rejection, so the rejection should be withdrawn.

The Examiner rejected claims 1-10, 14, 15 and 21-24 under 35 U.S.C. §102(b) as being anticipated by Narayanan.¹ As amended, claims 1-6, 8-10, 14, 15 and 21-24 cover compositions that include between about 75-95 weight percent catalyst and less than about 30 percent of non-electrolytic material by weight. Narayanan does not disclose such compositions. Rather, Narayanan discloses that his material contains a much larger amount of non-electrolytic material and a much smaller amount of catalyst. For example, Narayanan discloses a composition that includes 60%-70% NAFION plus 15%-20% TFE-30 (resulting in 75%-90% non-electrolytic binder) and only 7-10% catalyst. (*See, e.g., Narayanan* col. 3, line 58-col. 4, line 4). Moreover, there is no suggestion to modify Narayanan's material to provide the compositions covered by claims 1-6, 8-10, 14, 15 and 21-24. Applicants therefore request reconsideration and withdrawal of the rejection of these claims under 35 U.S.C. §102(b).

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Narayanan in view of Mitsunaga. Claim 9 depends from claim 1 and adds further features thereto. Accordingly, Narayanan does not disclose or suggest the compositions covered by claim 9. Nor does Mitsunaga cure Narayanan's infirmities at least because Mitsunaga does not disclose, or even suggest, the compositions covered by claim 9 which include between about 75-95 weight percent catalyst and less than about 30 percent of non-electrolytic material by weight.

Neither Narayanan nor Mitsunaga, either alone or in combination, discloses or suggests the compositions covered by claim 9. There is no suggestion to combine these references to provide such compositions. Moreover, even if the references were combined, the result would not be the compositions covered by claim 9. Applicants therefore request reconsideration and withdrawal of the rejection of claim 9 under 35 U.S.C. §103(a).

The Examiner rejected claims 16 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Narayanan in view of Surampudi. Claims 16 and 18-20 cover compositions that include between about 75-95 weight percent catalyst and less than about 30 percent of non-electrolytic material by weight. As explained above, Narayanan does not disclose, or even suggest, such compositions.

¹ Applicants cancelled claim 7, so the rejection of this claim should be withdrawn.

Surampudi does not cure Narayanan's infirmities at least because Surampudi does not disclose, or even suggest, compositions that include between about 75-95 weight percent catalyst and less than about 30 percent of non-electrolytic material by weight.

Neither Narayanan nor Surampudi, either alone or in combination, discloses or suggests the compositions covered by claims 16 and 18-20. There is no suggestion to combine these references to provide such compositions. Moreover, even if the references were combined, the result would not be the compositions covered by claims 16 and 18-20. Applicants therefore request reconsideration and withdrawal of the rejection of claims 16 and 18-20 under 35 U.S.C. §103(a).

Applicants believe the application is in condition for allowance, which action is requested. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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